

REMARKS

Claims 1 – 20 were pending. Claims 1, 5, 6, 8, 12, 13, 15, 17 have been amended; claims 2, 3, 9, and 10 have been canceled; and new claims 21 - 24 have been added. Accordingly, claims 1, 4 - 8, and 11 - 24 are presented for reconsideration and further examination in view of the following remarks.

In the outstanding Office Action, the Examiner rejected claim 17 under 35 U.S.C. § 112, 1st paragraph as failing to comply with the enablement requirement; and rejected claims 1 - 16 and 18 - 20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,150,458 to Masuzaki et al. in view of U.S. Patent No. 6,373,603 to Popovich et al.

By this Amendment, claims 1, 5, 6, 8, 12, 13, 15, 17 are amended; claims 2, 3, 9, and 10 have been canceled; claims 21 - 24 have been added; and all the rejections are respectfully traversed. Support for the amendments to claims 1, 8, and 15 can be found for example on page 17, lines 4 - 11 of the Specification. Claims 5, 6, 12, and 13 have been amended for punctuation only. Claim 17 has been amended to overcome the rejection under 35 U.S.C. § 112, 2nd paragraph. Support for new claims 21 - 24 can be found in Figures 10, 11 and the corresponding description, for example.

It is therefore respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. § 132.

Rejection Under 35 U.S.C. 112(1st)

The Examiner rejected claim 17 as failing to comply with the enablement requirement. In particular, the Examiner asserts that there is no description of using “a maximum number of pages as

a means of defining it to be a reference file and what is the determination that takes place to combine the various pages and the reason for doing so.” See Office Action at page 2.

Response

The first paragraph of 35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [*emphasis added*].

Applicant respectfully submits that the specification is enabling as to the features of claim 17. For example, Figures 7 - 9, and 11 show an input data file 1 (reference file) having 6 pages and an input data file 2 (fewer pages) having 4 pages, wherein 2 blank pages are inserted to change the combination of pages. As discussed in the description of these figures, and in particular, on page 17, lines 16 - 18, “...the user can designate the combination of pages...” Therefore, Applicant submits that at least Figures 7 - 9, and 11, and the description thereof, enable one skilled in the art to make and/or use the invention as recited in claim 17.

The reason why an original monochromatic image file with a maximum number of pages is focused on is that a reference file is needed to rearrange pages or insert a blank sheet as shown in Figure 11 or Figure 9. If a reference file is not set up, the file to be arranged cannot be determined. It is quite reasonable for a person of ordinary skill in the art to select a file with a maximum number of pages as a reference file. However, in order to expedite prosecution, claim 17 has been amended for clarity.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, 1st paragraph be withdrawn.

Rejection Under 35 U.S.C. 103(a)

The Examiner rejected claims 1 - 16 and 18 - 20 as being unpatentable over Masuzaki et al. in view of Popovich et al.

Response

Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Applicant respectfully submits that the combination of references fails to teach or suggest all of the claim limitations.

A feature of the present invention is a display section “displaying collectively a plurality of image information of each of a plurality of desired original monochromatic images selected by an image-formation apparatus.” This feature is a necessary condition to solve the problems described on page 4, lines 5 - 24 of the Specification. Applicant submits that the combination of references do not disclose how to solve the problems of the prior art.

Independent claim 1, as amended, recites, *inter alia* : “an image-formation apparatus configured to form an original multicolor image for output by *selecting a plurality of desired*

original monochromatic images from among the original monochromatic images stored in the image-storage apparatus and *combining* the plurality of desired original monochromatic images;...wherein *at least one of* the image input apparatus, the image output apparatus, and the image-formation apparatus includes a display section displaying *collectively a plurality of* image information of *each of the plurality of desired original monochromatic images selected* by the image-formation apparatus” (emphasis added).

Independent claim 8 recites, *inter alia* : “a control section configured to form an original multicolor image for output by *selecting a plurality of desired original monochromatic images* from among the original monochromatic images stored in the image-storage section and *combining* the plurality of desired original monochromatic images;...wherein the control section outputs *collectively a plurality of* image information of the *plurality of desired original monochromatic images selected* by the control section to a display section provided at the external image input apparatus itself or via at least one of the first data input/output section and the second data input/output section” (emphasis added).

Independent claim 15 recites, *inter alia* : “selecting *a plurality of original monochromatic image files* for output from a plurality of desired original monochromatic image files for output,...displaying the plurality of rasterized image data at a display apparatus *collectively*; and forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining *the plurality of image data displayed collectively* at the display apparatus” (emphasis added).

Masuzaki et al. discloses an electronic image information filing apparatus displaying editing corrections. An image input device 6 is an image scanner for scanning and converting an image to

obtain two-dimensional, monochromatic image information. A CRT display controller 14 combines original image data 19 and editing data 20 so as to form resultant data. A CRT display displays an image obtained by combining the monochromatic image information from the original image memory 11 and the monochromatic image information from the editing image memory 12, on a display screen in color. *See* column 3, line 20 to column 4, line 68.

However, Masuzaki et al. fails to disclose ...selecting a plurality of desired original monochromatic images from among the original monochromatic images stored and combining the plurality of desired original monochromatic images; and a display section displaying/a control section outputting collectively a plurality of image information... as recited in claims 1 and 8 of the present invention. Masuzaki et al. also fails to disclose selecting a plurality of original monochromatic image files for output from a plurality of desired original monochromatic image files for output; and displaying the plurality of rasterized image data...collectively.

Instead, in Masuzaki et al., original image data stored in one memory is combined with editing image data stored in another memory. Thus, at least one of the combined images is not an original in Masuzaki et al. In contrast, in the present invention a plurality of original images stored in an image-storage apparatus are combined and displayed collectively in a display section, or a plurality of original image files are selected and displayed collectively for output.

The Examiner states that Masuzaki et al. fails to disclose the that the input apparatus, referred to by the Examiner as the image input device 6, has a display section for displaying image information of the plurality of desired original monochromatic images regarding claims 1 and 8. The Examiner also states that Masuzaki et al. fails to disclose images that are spooled in a queue and rasterized regarding claim 15. The Examiner cites Popovich et al. and mentions U.S. Patent No.

5,959,867 to Speciner (to show spooling and rasterizing are conventional) in an attempt to cure the deficiencies of Masuzaki et al.

Popovich et al. teaches an image generating system including compensation for chromatic dispersion. A display device 12 includes a plurality of regions 54, 56, 58 for displaying a color component of an image (emphasis added). Each of the images displayed is a monochromatic image containing only a portion of full final image a user of the system will view. See column 3, lines 21-45.

Accordingly, in Popovich et al., the display displays portions of an image in different areas of the display. In contrast, in the present invention, the display section collectively displays a plurality of image information. In addition, in the present invention, an original multicolor image file is formed by combining the plurality of image data displayed.

Therefore, if Masuzaki et al. is combined with Popovich et al., the invention of claims 1, 8, and 15 cannot be obtained. In other words, the combined image-formation apparatus of Masuzaki et al. and the display section of Popovich et al., can only display a set of a single page of an original monochromatic image and a single page of another original monochromatic image. However, the above analysis shows that such an image-formation apparatus cannot solve the problems discussed in the Background of the Invention section of the present application.

In this regard, the above feature of the present invention has an inventive step as described in the Specification on page 17, lines 4 - 11.

"In this way, the two original monochromatic image data for output
"input data file 1" and "input data file 2", are independent of each
other, are rasterized in page units and are displayed in a row on the

screen. The contents of the image and the state of the combination of the pages can thereby be presented to the user in an easy-to-understand manner, and the user can instruct for printing after visually confirming the displayed contents on the screen.”

Further, the Examiner notes that “it is obvious to display the monochromatic images in Masuzaki’s invention as well since one can understand that an user of the system would want to see what images are being merged to create a final image.” *See* Office Action at page 3. However, Applicant respectfully submits that the Examiner’s conclusion of obviousness is based on improper hindsight reasoning.

The Examiner’s judgment on obviousness includes knowledge gleaned only from Applicant’s disclosure. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). *See* for example, the description of Figure 7, wherein, “The contents of the image and the state of the combination of the pages can thereby be presented to the user in an easy-to-understand manner, and the user can instruct for printing after visually confirming the displayed contents on the screen.” *See* for example, the description of Figure 8, wherein, “The user can confirm whether the desired combination of pages has been achieved, and original multicolor image data for output which is just as intended can be outputted to the printing apparatus.” *See* for example, the description of Figure 9, wherein, “The user can confirm visually that the combined contents and the like which were set at the preview & combination setting dialogs 20 up through FIG. 9 are correctly expressed.”

Applicant also submits that the combination of the two references is "hindsight" because the motivation to combine the references is lacking. The problem solved by Masuzaki et al. is how to modify an original image and add new information thereto, and show what part of an image display

has been modified or is additional information. *See* column 1, line 66 to column 2, line 3. The problem solved by Popovich et al. is how the separate monochrome images can be fused into a single full color image. *See* column 1, lines 48-50. Therefore, there is no motivation to combine these prior art references because the nature of the problems to be solved is different. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004).

Therefore, even *assuming arguendo* that spooling and rasterizing are conventional as stated by the Examiner as being discussed in Speciner, Popovich et al. fails to cure the deficiencies of Masuzaki et al.

The Examiner has not shown that the combination references teaches or suggests all of the limitations recited in independent claims 1, 8, or 15 or that there is proper motivation to combine the references. Therefore, claims 1, 8, and 15 are asserted to be patentable over the cited references. Similarly, as dependent claims contain all of the limitations of the independent claim from which they depend, claims 4 - 7, 11 - 14, 16, and 18 - 20 are patentable over the cited references for at least the same reasons as claims 1, 8, and 15. The rejection of claims 2, 3, 9, and 10 is moot in view of the cancellation of these claims.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the outstanding rejection of claims 1 - 16 and 18 - 20 under 35 U.S.C. § 103(a).

New Claims

New claims 21 - 24 have been added to recite special functions of the present invention such as rearranging pages, inserting a blank sheet, and others. Support can be found in Figures 10, 11 and

the corresponding description, for example. Applicant submits that these claims are allowable at least for similar reasons regarding independent claims 1 and 15, from which they depend.

CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

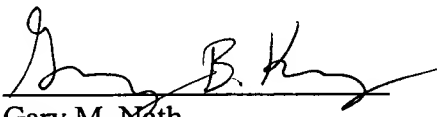
Respectfully submitted,

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